

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 2-10 remain in this application. Claim 1 has been canceled. Claims 11-15 have been added.

The Examiner objected to the title. A new title has been provided, making the objection moot.

The Examiner objected to claims 3-7 for having improper multiple dependencies. The claims have been amended, making the objection moot.

Claims 8 and 2 were rejected under 35 U.S.C. §102(b) as being anticipated by Weinrich (U.S. 5,033,090). For the following reasons, the rejections are respectfully traversed.

Claim 8, as amended, recites:

...an acoustical input being linked by means of a channel to a coupling opening arrangement exclusively at an outer surface of said device adapted to be exposed to ambient when an individual wears said hearing device....

Weinrich does not teach linking an acoustical input to a coupling opening exclusively at an outer surface device to be exposed to ambient. The channel 5 cited by the Examiner has an opening at both ambient (at 15) and at an interior (near 4). Thus, the cited reference does not teach the cited claim language, and thus claim 8 is patentable over the reference.

Claims 9, 10, and 4-7 were rejected under 35 U.S.C. §102(b) as being anticipated by Gauthier (U.S. 5,195,139). For the following reasons, the rejections are respectfully traversed.

Claim 9 has been canceled, making the rejection moot. Claim 10 recites that:

...said input or output is acoustically linked to a coupling opening via said channel forming an acoustic path from said input or output to said coupling opening exclusively at an outer surface of said device and adapted to be exposed to ambient or an ear canal of an individual wearing said hearing device but not both....

The reference clearly shows openings for channel 32 at both ambient and at a portion for entering an ear canal, and thus claim 10 is patentable over the reference.

Claim 11 recites an electrical/acoustical converter including an acoustical output in which

an acoustic path is formed from said output to a coupling opening entirely in said shell member using said channel, whereby said output is acoustically linked to said coupling opening via said channel along at least some portion of said acoustic path

Neither reference teaches such an output or channel, and thus claim 11 is patentable over the references.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gauthier in view of Johnson (U.S. 4,311,206).

Claim 3 depends on one of claims 8 or 11. Johnson fails to overcome the shortcomings of the Gauthier or Weinrich, and thus claim 3 is patentable over the references for at least that reason.

The remaining claims depend on one or more of the claims discussed above, and thus are patentable over the references for at least the same reasons as their parent claims.

Finally, the Examiner has not provided the proper motivation for combining the references in the rejections of claims for obviousness. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some

suggestion or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*).

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32992.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street, Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

March 7, 2005